Remarks/Arguments:

This is a reply to the office action of October 3.

Elected claims 22 - 31 have been rejected over prior art (U.S. Patent 3011436 to Berry, U.S. Patent 2999275 to Blume, Jr., U.S. Patent 3458311 to Alles, and U.S. Patent 5201268 to Yamamoto et al. Non-elected claims 32 - 59 were deemed withdrawn.

Figures 2 - 5 were objected to because they were too dark. Replacement drawings are submitted herewith. These are currently the best drawings available. We note MPEP 1893.03(f) indicates the PTO should not require new drawings in a national stage application if the drawings satisfied PCT Rule 11.

Claims 25, 27, 29 and 30 were rejected under 35 USC 112. Those claims have been amended to overcome the various reasons for rejection under section 112.

Claims 25 and 27 clearly state that the body of permanent magnetic material is mounted on a rotatable cylinder on a printing machine, or a support. This can also be gathered from page 9, first paragraph, of the published PCT publication.

In making the restriction requirement final, the examiner referred to the international search report, but did not consider the subsequent international preliminary examination report, where novelty and inventive step of all the claims was accepted. Inasmuch as the examiner's reasoning was based on a lack of unity "a posteriori", i.e. that the common inventive concept was known from the art, and the IPEA found otherwise, the examiner is invited to revisit this question.

We respectfully traverse the prior art rejections for reasons explained below.

Berry's patent concerns a latent magnetic image which is formed upon a plate of high retentivity magnetic material, and the use of such magnetic image- carrying plate (column 1, lines 39 to 64) for making a printing plate.

Berry discloses that a latent magnetic image is impressed upon a smooth surfaced ferromagnetic member of high magnetic retentivity by a suitable magnetizing member, such as a magnetic pen, with which a local magnetization of the surface of the ferromagnetic member is achieved, thereby producing an image.

Berry's ferromagnetic member does not comprise any engravings and does therefore not qualify as a body of permanent magnetic material in accordance with the present claims. Rather, a magnetic pattern is generated by a local magnetization of a part of the surface of the body.

In Berry's next step, the locally magnetized body is covered with a composition comprising magnetic particles, such as iron oxide powder. These magnetic particles adhere only to the locally magnetized portion of the surface of the body (column 2, lines 44 to 64). The adhering magnetic particles can now either be directly printed onto a substrate, or they may be used to transform the surface of the ferromagnetic member into a permanent ink-supporting plate of the relief-type, gravure-type or lithographic-type (column 4, lines 35 to 51 *et seq.*). The passage to which the examiner explicitly refers, i.e. column 5, lines 48 to column 6, lines 43, is related to the manufacturing of a *gravure plate*. In this respect, the latent image generated on the ferromagnetic member is "developed" with a mixture of powdered iron filings and a powdered acid anhydride such as P_2O_5, and subsequently exposed to moisture. Under these conditions, the acid anhydride is converted into free acid and reacts with the ferromagnetic member. An engraving in said ferromagnetic member is thereby produced (column 5, lines 67 to 72).

However, all that is done in Berry is to produce an engraved plate for the subsequent application of ink to a print receiving sheet. The engraved plate produced by the teaching of Berry is not intended to magnetically transfer indicia to a wet coating composition comprising magnetic or magnetizable particles, applied to a substrate. Even more, it is not even suitable for this purpose. The reason for that is simple: in above developing step, the magnetized zones of the initially smooth surface of the member are edged away by the acid, thereby generating the engravings. However, after all magnetized zones have been etched away with the acid, there is no area of magnetization left in the resulting gravure plate. A non-magnetized plate would not be suitable for magnetically transferring indicia to a wet coating composition comprising magnetic or magnetizable particles.

In this respect, we understand that the examiner has considered the above feature in question as a non-limiting indication of a purpose. However, in our opinion said feature at least requires that the device be suitable for the indicated purpose.
If it is not suitable for the indicated purpose, then it cannot be covered by the respective claim.

In any event, the gravure plate manufactured according to the teaching of Berry is not made of a permanent-magnetic material, and thus not meet one essential limitation of claim 22. As a consequence, the magnetic material is also not permanently magnetized in a direction substantially perpendicular to a surface of said body, simply because there is no magnetic material in the gravure plate.

According to the present invention, a sheet- or plate-like body of permanent magnetic material is engraved and magnetized in a direction substantially perpendicular to its surface (section [0027]), or as an alternative first magnetized and subsequently engraved (section [0029]).

The magnetization is only specified by a direction, and thus is locally homogenous over the entire sheet or plate, except for local perturbations which stem from the engravings, and which are caused by a local lack of magnetized magnetic material (section [0029]).

In contrast, when manufacturing a gravure plate, Berry does not homogeneously magnetize the ferromagnetic member, but rather creates local magnetization by using, e.g., a magnetic pen (Berry, column 3, lines 19 to 21). This is unlike the present invention; moreover, as noted above, in a subsequent step that locally magnetized area is removed in order to generate engravings. In consequence, there is no magnetization at all which could be used for a magnetic transfer of indicia.

Applicant respectfully submits that Berry is related to a different technical field than the present invention: while Berry teaches one how to manufacture a conventional (non-magnetic) gravure plate, the present invention comprises a permanent-magnetic body for magnetic transfer of indicia. This is something completely different.

The deficiencies of Berry cannot be overcome by combining Berry with Blume. Blume generally discloses the manufacture of permanent magnetic materials. Of course, the skilled person knows how to manufacture permanent magnetic materials. That is not the idea of the present invention. The present invention is about a specific application wherein a body of permanent magnetic material is magnetized in a direction perpendicular to its surface. A device comprising such a body of permanently magnetized material is not suggested at all in Blume.

It is respectfully submitted that even if, *arguendo*, a person had combined the teachings of Berry and Blume, he would not have arrived at the subject matter of claim 22, since the combination would not disclose all the elements of claim 22. Even the combination of Berry and Blume would not result in a body of permanent magnetic

material which is permanently magnetized in a direction substantially perpendicular to a surface of said body, and which is suitable for magnetically transferring indicia to a wet coating composition applied to a substrate, wherein the coating composition comprises at least one type of magnetic or magnetizable particles.

In order to arrive at the present invention, the skilled person would have had to modify the teachings of Berry and Blume. Even according to the KSR/Teleflex decision of the Supreme Court, the skilled person has to have some motivation to modify the prior art. In the present case, there is no apparent motivation which would have led the skilled person to modify the prior art into the direction of the present invention. Furthermore, in the absence of any suggestion that such a resulting device would be suitable for magnetically transferring indicia to a wet coating composition comprising at least one type of magnetic or magnetizable particles, resulting in very sharp and precise indicia, there would not have been any reasonable expectation of success for the skilled person when theoretically attempting to modify the prior art in the direction of the present invention.

For the above reasons, we submit that claim 22 is patentable over the prior art of record, the claims which depend from 22 are consequently patentable. We believe that this application is now in proper condition for allowance.

Respectfully submitted,

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